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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/593,460	09/19/2006	Peter Herold	2006_1373A	9975
513 7590 04/02/2010 WENDEROTH, LIND & PONACK, L.L.P. 1030 15th Street, N.W., Suite 400 East Washington, DC 20005-1503				
EXAMINER HAYLIN, ROBERT H				
ART UNIT		PAPER NUMBER		
1626				
NOTIFICATION DATE		DELIVERY MODE		
04/02/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ddalecki@wenderoth.com  
coa@wenderoth.com

# Office Action Summary

**Application No.**

10/593,460

**Applicant(s)**

HEROLD ET AL.

**Examiner**

ROBERT HAVLIN

**Art Unit**

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 and 7-10 is/are pending in the application.
- 4a) Of the above claim(s) 8-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

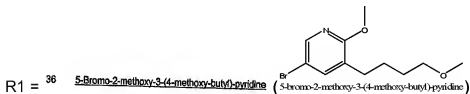
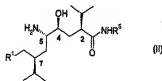
# **DETAILED ACTION**

**Status of the claims:** Claims 1-5, and 7-10 are currently pending.

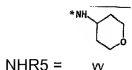
**Priority:** This application is a 371 of PCT/EP05/51244 (03/17/2005) and claims foreign priority to SWITZERLAND 00469/04 (03/19/2004). The certified priority documents are not of record.

## ***Election/Restrictions***

1. Applicant previously elected Group I (claims 1-7) and also elected the following species (reading on claims 1-7):



Presumably attached to formula (II) to replace the 5-bromo position;



As detailed in the following rejections, the generic claim encompassing the elected species was not found patentable. Therefore, the provisional election of species is given effect, the examination is restricted to the elected species only, and



where, in the case that R<sup>1</sup> is naphthyl or cyclohexenophenyl, at least the ring of said R<sup>1</sup> radicals not bonded directly to X is substituted as specified; or

Giving the claims their broadest reasonable interpretation, the R1 rings are "substituted as specified." Accordingly, the **rejection is maintained** for pending claims 1-5 and 7.

***Claim Rejections - 35 USC § 112***

4. Claims 1-7 were rejected under 35 U.S.C. 112, first paragraph, because the specification does not reasonably provide enablement for the asserted utility of the entirety of the claim scope.

In response to the rejection, applicant included with their argument experimental data titled "TEST REPORT." This type of data is that which is properly presented in the form of a 37 CFR 1.132 declaration and not as argument. See MPEP § 2145, § 716. Applicant also points to a single line of page 16 stating: "[t]he compounds of the present invention exhibit inhibiting actions in the in vitro systems at minimum concentrations of about 10<sup>-6</sup> to about 10<sup>-10</sup> mol/l." Based on this level of disclosure, one of skill in the art would not be appropriately informed as to whether the compounds were actually tested to show activity relevant to the compound's utility. Furthermore, it is not clear which compounds, what "in vitro systems," or what "inhibiting actions" were demonstrated. As referred to in the prior office action, this statement appears to be a "paper example" improperly represented as work actually done and lacks the level of specificity necessary to guide one of skill in the art.

Therefore, because there is substantial unpredictability in the art and the disclosure of the specification does not contain any examples demonstrating the relevant utility of the compounds, this rejection is **maintained**.

### ***Double Patenting***

5. Claims 1-7 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 12-20, and 22-23 of copending Application No. 11/992132.

Applicant requests this rejection be held in abeyance until the claims are otherwise in condition for allowance. Therefore, this rejection is **maintained**.

### ***Conclusion***

The claims are not in condition for allowance. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT HAVLIN whose telephone number is (571)272-9066. The examiner can normally be reached on Mon. - Fri., 7:30am-5pm EST.

If attempts to reach the examiner by telephone are unsuccessful the examiner's supervisor, Joe McKane can be reached at (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert Havlin/  
Examiner, Art Unit 1626

/Rebecca L Anderson/  
Primary Examiner, Art Unit 1626